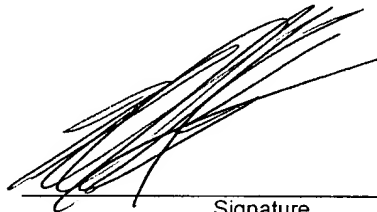


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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 1163-0329P	
	Application Number 09/802,961-Conf. #2653	Filed March 12, 2001	
	First Named Inventor Toyokazu SUGAI et al.		
	Art Unit 2611	Examiner H. V. Tran	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number _____</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. <u>29,680</u></p> <p> _____ Signature</p> <p>_____ Michael K. Mutter Typed or printed name</p> <p>_____ (703) 205-8000 Telephone number</p> <p>_____ November 1, 2005 Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

Off



Docket No.: 1163-0329P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Toyokazu SUGAI et al.

Application No.: 09/802,961

Confirmation No.: 2653

Filed: March 12, 2001

Art Unit: 2611

For: ELECTRONIC PROGRAM GUIDE PROVIDING
DEVICE

Examiner: H. V. Tran

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In addition to the Notice of Appeal which is being concurrently filed, Applicants respectfully request a Pre-Appeal Brief Conference to consider the issues raised in the Office Action dated July 1, 2005, that finally rejected claims 1-19.

A. Rejection Under 35 U.S.C. § 102

The Examiner has finally rejected claims 1-19 under the provisions of 35 U.S.C. § 102(b) as being anticipated by U. S. Patent 5,666,654 (Thomas et al., hereinafter "Thomas").

B. The Thomas Patent neither explicitly nor inherently teaches an electronic program guide device that updates and regenerates the program guide of claim 1

It is respectfully submitted that Thomas does not explicitly or inherently disclose an electronic program guide providing device having an editing system that updates the program guide by separately regenerating the first table of events at a time or in content different from the second table of events. In the Applicants' claimed invention, only the first electric program guide table that needs to be updated immediately is regenerated, and the other updating related to the second table is deferred and then transmitted. By delaying the regeneration of the second table, Applicants have discovered that they are able to obtain an improved program

guide which eliminates unnecessary updating steps and simplifies the regeneration of the tables used to create the program guide.

The Office Action relies upon the teachings at col. 8, lines 32-42 of the Thomas which describes a *validation or verification subsystem* and states:

The database validation or verification subsystem 30 is used to **review the information contained in the main database 90 for corrections**. For example, the database validation subsystem generates a report 35 (FIG. 1) on the database for determining if text fit corrections are necessary. It receives configuration information identifying the feeds and editions which must be supported and verifies that all of the data necessary to create the feeds and editions is present and correct. The database validation subsystem operates automatically on either the entire database or any subset thereof designated by the operator. Subsets may be designated by defining the time window and particular editions to be validated. [Emphasis added].

It is clear that the validation or verification subsystem merely verifies the information or a subset of the information contained in the database for corrections. It is also clear that the validation or **verification system does not separately update or regenerate first and second tables**, as claimed by the Applicants. The verification system of Thomas also does not explicitly or inherently disclose delaying the regeneration of the second table of events until a later predetermined time. The verification system of Thomas simply verifies data, and it does not separately regenerate first and second tables. Accordingly, Thomas does not provide any explicit teaching that anticipates claim 1.

C. The Office Action Does Not Adequately Support A Finding Of Inherency

The Office Action on page 2 makes it clear that the rejection under 35 U.S.C. § 102(b) is based upon **inherency**. The Applicants respectfully submit that the Office Action fails to establish that Thomas *inherently* discloses Applicants' claimed invention. The Office Action states that Thomas *inherently* discloses the 1st and 2nd tables that are separately regenerated (see July 1, 2005 Office Action, page 2, line 6). It is respectfully submitted that the cited portions of Thomas do not explicitly or *inherently* disclose that the 1st and 2nd tables of Thomas are separately regenerated.

The law regarding a rejection based upon inherency is clear. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result

due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

It is respectfully submitted that the Office Action has not shown that Thomas updates the program guide by separately regenerating the first table of events at a time or in content different from the second table of events. Even if Thomas arguably discloses two of the claimed "tables", which it does not, the two "two tables are not separately regenerated. The Office Action cites the passage at col. 12, lines 9-11 for the proposition that the "tables" are regenerated separately. The Applicants respectfully disagree. Thomas teaches that data for programs scheduled for the present day will be included more frequently in the feed than data for programs airing in a week. The feeding of data scheduled for the present day, which is more likely to be requested, is not the same as regenerating tables.

The Applicants believe that the rejection under 35 U.S.C. § 102(b) must be withdrawn, because the Examiner's position regarding inherency is unsupported by the explicit teachings of Thomas. Thomas explicitly discloses a verification subsystem that merely verifies subsets of the information contained in the database for corrections, and then more frequently feeds program data which is scheduled for the present day. Accordingly, the Applicants respectfully submit that Thomas does not anticipate independent claim 1, and that independent claim 1 is patentable over Thomas.

Dependent Claims 2-19

Applicants also respectfully submit that dependent claims 2-19 which all depend from claim 1 are patentable for at least the same reasons as independent claim 1.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard J. McGrath (Reg. No. 29,195) at the telephone number of (703) 205-8000, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: November 1, 2005

Respectfully submitted,

By

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